

## **REMARKS**

### **Election of Species**

The Office Action asserts that the application contains claims directed to the following allegedly patentably distinct species:

Species A:	paragraph [0008], lines 4-5 (same location as a client)
Species B:	paragraph [0008], lines 5-6 (remotely located from client system)
Species C:	paragraph [0008], lines 10-11 (direct interaction)
Species D:	paragraph [0008], lines 11-12 (indirect interaction)
Species E:	paragraph [0008], lines 13-14 (synchronous interaction)
Species F:	paragraph [0008], lines 15 (asynchronous interaction)
Species G:	paragraph [00011], line 13 (client/server as separate computer system)
Species H:	paragraph [0014] (authentication)
Species I:	paragraph [0015] (digital signature)
Species J:	paragraph [0016] (encryption)
Species K:	paragraph [0017] (access control)
Species L:	paragraph [0018] (faceless receipt)
Species M:	paragraph [0019] (taxes)
Species N:	paragraph [0020] (unicode)
Species O:	paragraph [0021] (XML)
Species P:	figure 2 and paragraph [0023] (according to an alternate embodiment)
Species Q:	paragraph [0026], lines 16-18 (statistical analysis)
Species R:	paragraph [0031], lines 3-4 (identifier)
Species S:	paragraph [0032], lines 7-8 (notary module)

Applicants hereby **elect alleged Species G with traverse** only insofar as such an election is required in order to be fully responsive to a restriction requirement per 37 C.F.R.

§1.143. Furthermore, Applicants list each of pending claims 1-50 as reading on alleged Species G only insofar as such a listing of claims readable on an elected species is also required in order to be fully responsive to a restriction requirement per 37 C.F.R. §1.143. Applicants traverse the above restriction requirement for at least the following reasons.

MPEP § 802, states that the statutory basis for the restriction of an application comes from the following language: “If two or more independent and distinct inventions **are claimed** in one application” restriction may be required (35 U.S.C. 121, emphasis added); “Two or more independent and distinct inventions may not be **claimed** in one national application...” (37 CFR 1.141, emphasis added); and “If two or more

independent and distinct inventions are **claimed** in a single application,” the application may be restricted (37 CFR 1.142, emphasis added). Similarly, M.P.E.P. §808.02 states that restriction under 35 U.S.C. 121 is never proper where related inventions are not patentably distinct **as claimed**, where the inventions **as claimed** are **shown to be** independent or distinct under the criteria of MPEP § 806.05(c) - § 806.06.

Applicants respectfully submit that the Office Action fails to make any **showing** that Applicants invention **as claimed** are independent or distinct. More particularly, the Office Action improperly asserts alleged Species A-S based **solely** upon excerpts from the specification, and **without** any reference to the **claims themselves**. While it has been **generally** asserted that the “application contains claims directed to ... patentably distinct species,” the Office Action provides no **specific** indication as to how the **claims themselves** support the contention that the application includes multiple inventions which are patentably distinct **as claimed**. More particularly, there has been no specific assertion of which, if any, of the **actual claims** pertain to independent and distinct inventions. Similarly, while it has been generally averred that “no claims are generic,” there is no specific assertion as to which claims are independent and distinct species. Therefore Applicant submits that there has been **no valid assertion** that more than one patentably distinct invention has been **claimed**.

Applicants respectfully submit that a proper restriction requirement has not been established, and that for at least the following reasons the claims are not directed to multiple patentably distinct species. Firstly, MPEP § 806.04(e) states that: “Species always refer to the different embodiments of the invention.” Applicants note that the use of phrases such as “according to an embodiment of the invention” (page 5, para. [0007]), or “[i]n an embodiment” (page 8, para. [00014]) in reference to disclosed features in Applicant’s application **do not restrict** each disclosed feature to a different embodiment. Rather, as stated on page 20, para. [00045] of the specification (emphasis added):

‘It should be appreciated that reference throughout this specification to “one embodiment” or “an embodiment” means that a particular feature, structure or characteristic described in connection with the embodiment is included in at least one embodiment of the present invention. Therefore, **it is emphasized** and should be appreciated that two or more references to “an embodiment” or “one

embodiment” or “an alternative embodiment” in various portions of this specification are **not necessarily** all referring to the same embodiment. Furthermore, the particular features, structures or characteristics **may be combined as suitable in one or more embodiments** of the invention.’

Accordingly, “[e]mbodiments of the invention are illustrated by way of example, and not by way of limitation” (page 4, para. [0005]).

Therefore Applicant respectfully submits that the various figures and passages of the specification which are alleged to describe patently distinct species are merely **illustrative** of particular features, structures or characteristics which, although they **may be combined** as suitable **in one or more embodiments** of the invention, are not themselves **restricted** to “different embodiments” or species.

Furthermore, even assuming *arguendo* that two or more species were claimed, which Applicants do not agree, MPEP § 806.04(f) states that:

“Where two or more species are claimed, a requirement for restriction to a single species may be proper if the species are mutually exclusive. ... This may ... be expressed by saying that to require restriction between claims limited to species, the claims must not overlap in scope.”

No assertion has been made as to whether or not claims overlap in scope. Applicants respectfully submit that all claims 1-50 are readable at least upon alleged Species G. Therefore, alleged Species G overlaps all other possible purported species, meaning there are no mutually exclusive species.

Furthermore, even assuming *arguendo* that the claims were directed to patentably distinct inventions, which Applicants do not agree, Applicants respectfully submit that the Office Action improperly imposes a restriction requirement without alleging that there is an **undue burden** on the Examiner. As stated in M.P.E.P. §803 (emphasis added)

“If the search and examination of all the claims in an application can be made **without serious burden**, the examiner **must examine them** on the merits, **even though** they include claims to independent or distinct inventions.”

The guidelines in M.P.E.P. §803(II) state (emphasis added):

“Examiners **must provide reasons and/or examples to support conclusions**...For purposes of the initial requirement, a **serious burden** on the examiner may be *prima facie* shown by **appropriate explanation** of separate

classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing **may be rebutted** by appropriate showings or evidence by the applicant....”

No allegation is made in the Office Action that further prosecution of the pending claims would impose a serious burden on the Examiner. Applicants respectfully submit that the failure of the Office Action **to even allege** a serious burden on the Examiner, let alone offer any reasons and/or examples to support such an allegation, is dispositive of the improper nature of the restriction requirement. Furthermore, to the extent that the Office Action fails to provide any indication as to which claims are directed to which alleged patentably distinct species, Applicants are unable to address how, for example, any one claim may represent a separate classification, or separate status in the art, or a different field of search with respect to any other claim.

Applicants respectfully submit that there is **no such serious burden**, as evidenced at least by the prosecution which has already taken place without a need to impose a restriction requirement. Particularly illustrative of there being no serious burden on the Examiner is the fact that the Office Action relies on the specification – **and not** the claims – as the basis for asserting allegedly patentably distinct species A-S. However, this same specification has been the subject of examination for Office Actions of February 01, 2007 and July 05, 2007 as well as an Advisory Action of September 10, 2007 – without any need to impose a restriction requirement. The Office Action does not allege that any claim amendments have given rise to a need for a restriction requirement, and a review of Applicants’ August 30, 2007 communication does not suggest how the most recent claim amendments might give rise to a **nineteen way restriction** of Applicants’ invention.

Applicants respectfully submit that the absence of any previously-asserted restriction requirement in the course of earlier prosecution of this case is indicative of there being **no serious burden** on the Examiner, and that an assertion of such a restriction requirement at this time contradicts the statement of M.P.E.P. §707.07(g) that **piecemeal examination** should be **avoided** as much as possible. Accordingly, the above restriction requirement of the Office Action is **improper**, and Applicants respectfully request that said restriction requirement be withdrawn.

CONCLUSION

For at least the foregoing reasons, Applicants submit that the restriction requirement of the Office Action has been overcome. Applicants also assert that, for at least the reasons set forth in Applicants communication of August 30, 2007, claims 1-50 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application. Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,  
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Date: 1/28/2008

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